

## REMARKS

Claims 1-24 are currently pending in the application. The Office Action required restriction of the application to two separate inventions (claims 1-22 and claims 23-24). The Office Action noted that a French reference in the January 31, 2001 Information Disclosure Statement was not considered because it lacked a translation or concise explanation of the relevance. The Office Action objected to the drawings under 37 C.F.R. 1.84(p)(5) because they include references not mentioned in the description. The Office Action objected to claims 4 and 21-22 under 37 C.F.R. 1.75 as substantially duplicative of other claims. The Office Action rejected claims 1, 6, 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by JP03168685, issued to Arai et al.; claims 2 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Arai et al.; claims 3-5, 7-10, 14-17 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Arai et al. further in view of U.S. Patent No. 1,973,900, issued to Hylander; claims 11, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Arai et al. and Hylander, further in view of U.S. Patent No. 6,190,174, issued to Lam; and claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Arai et al., further in view of Lam.

Applicant respectfully addresses the objections and traverses all of the rejections made in the Office Action and, pursuant to 37 C.F.R. § 1.111, requests reconsideration of the application.

### AFFIRMATION OF ELECTION

In response to the Office Action, and in response to the Election/Restriction requirement made by the Examiner, Applicant elects, with traverse, claims 1-22. As set forth in the Office Action, this election is to prosecute Group I. Please cancel claims 23-24 of Group II without prejudice.

### INFORMATION DISCLOSURE STATEMENT

The Office Action noted that a French reference in the January 31, 2001 Information Disclosure Statement was not considered because a translation or concise explanation of the



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relevance was not submitted. Applicant provides a concise explanation of the relevance of French Patent No. 88 05564:

This patent is directed to a procedure for taking measurements of buildings using telemetry. More specifically, the invention is a software system that uses lasers and a form of triangulation to calculate the dimensions of a room.

#### AMENDMENT TO CORRECT DRAWINGS

The Office Action objected to the drawings because reference numbers 36 and 78 were not mentioned in the description. Reference number 36 was inadvertently not mentioned where the device which it references (magnet) was described on page 5, line 11. The absence of reference number 78 was due to a typographical error on page 6, line 10, where number 76 was inadvertently used rather than reference number 78. Applicant has amended the specification to include these reference numbers. Applicant submits that no new matter was added to make these corrections.

#### CLAIM OBJECTIONS

The Office Action objected to claims 4 and 21-22 under 37 C.F.R. 1.75 as substantially duplicative of other claims. Applicant has amended independent claim 4 and dependent claim 5 to more accurately claim the present invention. As amended, claim 4 is directed to a "system" for use in association with design plans, the system including a "first component" and a "second component." Applicant submits that the system and first and second components claimed in claim 4 is substantially different in both wording and scope from the design tool, member and wand claimed in claims 1 and 3, and therefore is not objectionable under 37 C.F.R. 1.75.

Likewise, claims 21 and 22 are substantially different from claim 1. Claim 1 is directed to a design tool including "a *member* having a first surface and a second surface, the second surface engageable with the design plans . . . ." (emphasis added). In contrast, claim 21 is directed to a design tool including "a *means* engageable with the design plans . . . ." (emphasis added). Likewise, claim 22, as amended, is directed to a design tool including "a *first means* engageable



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with the design plans” and further “a *second means* for supporting the first means in operation of the design tool.” Applicant respectfully submits that claims 21 and 22 are not duplicative of claim 1, either in wording or scope.

**REJECTION OF CLAIMS 1, 6, 21 AND 22 UNDER 35 U.S.C. § 102(b)**

The Office Action rejected claims 1, 6, 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by JP03168685, issued to Arai et al. Applicants respectfully submit that Arai et al. do not in fact disclose the limitations set forth in claims 1, 6, 21 and 22.

Arai et al. is directed to a model housing box for buildings, an invention dramatically different from that of Applicant. The stated purpose of Arai et al. is:

To facilitate the transportation and storage of models for proposition of disposition plans of buildings and others by providing magnetic materials or magnets on racks of the housing box and housing the models of buildings, vehicles, trees, etc., thereon by magnetizing the same.

Significantly, the abstract of Arai et al. discloses only elements applicable to a model housing box:

The housing box 7 is opened on the front side and rack rests 8 are provided in plural stages above and below in the inside. The racks 9 are freely drawably forward are imposed on the rack rests 8. The racks 9 are provided with the magnets or magnetic materials so that the models 4 of the buildings, vehicles, trees, etc., having the magnets or magnetic materials can be imposed and magnetized on the racks 9. Thus, the models 4 are housed on the racks 9 in the state of magnetizing and the transportation and storage of the models 4 are facilitated without moving the models 4 even when gripping parts 10 are moved by holding the same with hand.

Objectively viewing this reference, including the figures shown therein, nowhere do Arai et al. disclose the invention of claims 1, 6, 21 and 22. ***Claims 1, 6, 21 and 22*** claim a member, base or means “scaled to indicate a turning radius to imitate the turning radius of a support device used by persons with disabilities and the aging population.” There is no



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disclosure in Arai et al. indicating that element 13 constitutes this limitation. The most that can be said of element 13 is that it appears to be a pair of sticks, tracks or rails.

**Claim 6** further claims an icon figure attached to the first surface of the base and “sized to the scale of the design plans to allow accurate representation of the movement of persons with disabilities and the aging population along the hallways, doorways, stairways, rooms and other spaces of the design plan to visually illustrate the feasibility of movement along the noted paths in light of the size and turning radius of the represented person.” There is no indication that element 4k is a scaled icon figure used to represent the movement of persons with disabilities and the aging population. The most that can be said of element 4k is that it is a small figurine in the shape of a person.

**Claim 22**, as amended, further claims a “second means for supporting the first means in operation of the design tool.” Arai et al. do not disclose a means for supporting the first means, member or base “in operation of the design tool,” namely, in using the tool to “indicate a turning radius to imitate the turning radius of a support device.”

Arai et al. do not anticipate claims 1, 6, 21 or 22.

#### **REJECTION OF CLAIMS 2 AND 13 UNDER 35 U.S.C. § 103(a)**

The Office Action rejected claims 2 and 13 under 35 U.S.C. § 103(a) as being unpatentable over JP03168685, issued to Arai et al. Claims 2 and 13 depend upon independent claims 1 and 6, respectively, and are therefore patentable over Arai et al. for the same reasons that make claims 1 and 6 patentable, as noted above.

#### **REJECTION OF CLAIMS 3-5, 7-10, 14-17 AND 20 UNDER 35 U.S.C. § 103(a)**

The Office Action rejected claims 3-5, 7-10, 14-17 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Arai et al. further in view of U.S. Patent No. 1,973,900, issued to Hylander. Claim 3 depends upon independent claim 1 and claims 7-10 depend upon independent claim 6, and are therefore patentable over the cited references for the same reasons that make



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claims 1 and 6 patentable, as noted above. In addition, there are alternative bases for the patentability of a number of these dependent claims, as well independent bases for the patentability of claims 4-5, 14-17 and 20.

According to the Office Action, Arai et al. do not disclose expressly a wand extending from and supporting the member in operation of the design tool, the wand having a first end and a second end. The Office Action states that Hylander discloses a traffic position indicating model that uses wands 32, with openings 27 from which the wands depend, having upper ends and bases 33, maintained by frictional contact in the form of a nut and threaded end, extending from the tops of model cars 24. The Office Action suggests that Arai et al. are combinable in an obvious manner with Hylander to produce the claimed present invention. Applicant respectfully submits that the inventions of Arai et al. and Hylander are not combinable as suggested, the teachings of Arai et al. and Hylander provide no motivation to combine one with another, and that in fact Arai et al. and Hylander teach away from each other.

Hylander is directed to a traffic location-indicating model wherein the traffic elements can be positioned in the exact geometrical relation as existed on the street where the accident occurred. A principal object of Hylander is to provide a model wherein the parts are capable of ready manipulation. (Page 1, lines 8-17.) The rod 32 of Hylander facilitates these purposes. As set forth in Hylander, the rod 32 is securely fastened on its lower end to an inverted V-shaped member via a nut, and includes a knob 32c on the upper end to permit easy manipulation of the rod to adjust the traffic element (car) with respect to the board (street). (Page 2, lines 9-79.)

The figurines 4k disclosed in Arai et al. are not combinable with the rod 32 configuration disclosed in Hylander. The figurines in Arai et al. are designed to be readily moved within the building model via tweezers 14 and rod 17. Neither of these components is made to affix to or be "securely fastened" to the figurines. In contrast, the rod 32 of Hylander is specifically designed to be securely fastened to the traffic element via a nut. There is no structural accommodation for the securely fastened rod and nut assembly of Hylander in the figurines 4k of Arai et al.



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Moreover, both Arai et al. and Hylander teach away from the structure of the other. An express object of Arai et al. is to facilitate the transportation and storage of models. This requires the easy collapse and storage of the model components. In contrast, the Hylander model is designed for easy manipulation of traffic elements along a street for public demonstration, for example, in a courtroom. (Page 1, lines 1-7.) Given the structural differences between Arai et al. and Hylander precluding their combination, as well as the express teaching away from each other vis-à-vis use of securely fastened rods, Applicant submits that claims 3-5, 7-10, 14-17 and 20 are patentable over Arai et al. in view of Hylander.

**Claims 8 and 15.** Neither Arai et al. nor Hylander disclose or teach the use of an icon figure including “an opening having an upper end and a base, the opening corresponds in size to the first end of the wand, and the first end of the wand is maintained within the opening of the icon figure.” Moreover, for the reasons set forth above, the use of the securely fastened rod 32 of Hylander is not combinable with the figurine 4k of Arai et al.

**Claims 9 and 20.** As acknowledged in the Office Action, neither Arai et al. nor Hylander disclose or teach the use of a wand wherein “the first end of the wand is maintained within the opening of the icon figure by frictional contact of the first end of the wand to the interior of the opening.” Moreover, for the reasons set forth above, the use of the securely fastened rod 32 of Hylander is not combinable with the figurine 4k of Arai et al.

**Claims 10 and 17.** Neither Arai et al. nor Hylander disclose or teach the use of an icon figure including “a metal plate located at the base of the opening, the first end of the wand includes a magnet, and the wand is maintained within the opening of the icon figure by the metal plate-magnet combination.” Moreover, for the reasons set forth above, the use of the securely fastened rod 32 of Hylander is not combinable with the figurine 4k of Arai et al.

Claims 3-5, 7-10, 14-17 and 20 are patentable over the cited references.



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## REJECTION OF CLAIMS 11, 18 AND 19 UNDER 35 U.S.C. § 103(a)

The Office Action rejected claims 11, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Arai et al. and Hylander, further in view of U.S. Patent No. 6,190,174, issued to Lam. Claim 11 depends on independent claim 1 and claims 18 and 19 depend on independent claim 14, and are therefore patentable for the same reasons that make claims 1 and 14 patentable, as noted above. These claims are also patentable further in view of Lam.

**Claims 11 and 18.** The Office Action states that the snap-lock means of module 26 using tabs to fit into holes 46, 48 make the ridge-locking structure of the present invention obvious. However, Lam is directed to an electronic toy, and there is no indication that module 26 discloses any type of ridge-locking structure, let alone the structure claimed in the present invention. Rather, module 26 of Lam indicates only that connectors 46, 48 provide an electrical connection “to facilitate the multi-mode ‘telling’ of the story.” (Col. 3, lines 22-25.) In addition, there is no teaching that electrical connectors used in the electronic toy of Lam could be combined with the figurines of Arai et al. Finally, the cited references teach away from each other. Lam is an electronic toy, wherein the module 26 connects to a base via connectors 46, 48. In contrast, Arai et al. is directed to a model housing box for buildings having figurines and Hylander is directed to a traffic location-indicating model wherein the traffic elements can be positioned in the exact geometrical relation as existed on the street where the accident occurred.

**Claim 19.** The Office Action states that icon 20 of Lam has a base equal to the diameter of the icon figure. However, the only reference to the size of icon 20 is as shown in Figure 1, wherein the base in fact appears smaller in diameter than icon 20. Moreover, there is no teaching towards combining the icon 20, having a base, with the figurines of Arai et al. or the cars of Hylander, which do not include bases.

Claims 11, 18 and 19 are patentable over the cited references.



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## REJECTION OF CLAIM 12 UNDER 35 U.S.C. § 103(a)

The Office Action rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Arai et al. further in view of Lam. Claim 12 depends upon independent claim 6 and is therefore patentable over the cited references for the same reasons that make claim 1 patentable, as noted above. This claim is also patentable for the independent reasons discussed above with respect to claim 19.

## CONCLUSION

Based upon the above remarks, Applicant respectfully requests reconsideration of the application and its early allowance. The Examiner is invited to contact the undersigned should direct communication on this matter be deemed helpful to facilitate progression of the case.

Respectfully submitted,

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## VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please replace the paragraph beginning at page 5, line 1 with the following rewritten paragraph:

--As shown with specific reference to FIGURES 1, 4 and 5, wand 50 of the design tool is preferably made out of molded plastic, is oval shaped (for added structural strength), and is sized to allow a user to comfortably hold one end of the wand while supporting movement of the icon figure and base as it is used with a design plan. In the preferred embodiment, the wand is tapered and the opening is correspondingly tapered to receive one end of the wand. It will be appreciated that the wand may be made out of different materials, and may vary in specific shape and size, so long as it functions to support the weight of the icon figure and allows comfortable usage. More specifically, one end of wand 50 is inserted into opening 32 of chair back 30 of icon figure 20. The wand is maintained in the opening in a variety of ways. In the preferred embodiment, with the larger scale icon figures, one end of the wand includes a magnet 36. The end of the wand with the magnet is inserted into opening 32 against metal plate 34, thereby removably connecting the wand to the icon figure. Alternatively, the wand may be maintained in the opening of the icon figure by frictional contact of the wand to the interior of the opening. For example, due to size restrictions, the 1/8" scale icon figure has a smaller tapered wand and does not use a metal plate-magnet combination, relying on frictional contact. Further alternative means of maintaining the wand in the opening to support the icon figure and the base are contemplated. For example, the end of the wand to be inserted into the opening could further include ridges or locks corresponding to ridges or locks located within the opening. In such an embodiment, the wand is snap-fit into place to secure the wand during operation, yet can, upon use of additional applied force, be removed from the icon figure for transportation or storage. The wand may also be held in place in a permanent fashion by use of, for example, glue, or a screw extending from one end of the wand into the body of the icon figure. Regardless of the particular embodiment, the wand remains in place when the user releases the wand during operation.--

Please replace the paragraph beginning at page 6, line 3 with the following rewritten paragraph:

--As better understood with reference to FIGURE 7, an alternative embodiment of the present invention provides design tool packaging 70 in association with the design tool, including the wand. Design tool packaging 70 comprises pliable support structure 72, preferably made from Urethane foam, out of which one or more holes 74 and 76 are cut. Each hole 74 is



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sized to receive a scaled icon figure and corresponding base so as to prominently display the icon figure outwards from support structure 72. Each hole 76 is sized to receive a corresponding wand. The design tool packaging is slidably encased by an exterior translucent film material [76] 78, preferably polycarbonate film. When in use around the design tool packaging, the film material maintains the design tool, including wand, securely within the design tool packaging, and protects the design tool and wand, while at the same time providing convenient viewing of the packaging contents.--

#### IN THE CLAIMS:

Please amend the following claims, as noted.

4. (Amended) A [design tool] system for use in association with design plans having hallways, doorways, stairways, rooms and other spaces of a known scale, for functional and space planning in the fields of architecture, interior design, and construction of residential and commercial structures, comprising a [member] first component having a first surface and a second surface, the second surface engageable with the design plans, the [member] first component scaled to indicate a turning radius to imitate the turning radius of a support device used by persons with disabilities and the aging population, and a [wand] second component extending from and supporting the [member] first component [in operation of the design tool].

5. (Amended) The [design tool] system of claim 4, wherein the [icon figure] first component is shaped as a human seated in a wheelchair, and includes an upper torso portion, a lower torso portion, a head portion, and a wheelchair portion having wheels on both sides of the human shape and a chair back at the rear of the human shape.

22. (Amended) A design tool for use in association with design plans having hallways, doorways, stairways, rooms and other spaces of a known scale, for functional and space planning in the fields of architecture, interior design, and construction of residential and commercial structures, comprising a [member] first means engageable with the design plans and scaled to indicate a turning radius to imitate the turning radius of a support device used by persons with



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disabilities and the aging population, and a second means for supporting the [member] first means in operation of the design tool.



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